

REMARKS

Status of Claims

Claims 1-20, 41, and 42 are pending. Claim 1 has been amended. Support for the amendment made to claim 1 is found at page 17, paragraph 56, of the specification as originally filed. Claims 41 and 42 have been cancelled without prejudice. Claims 1-20 remain for consideration upon entry of the present Amendment. No new matter has been added.

Claim Rejections – 35 U.S.C. §103(a)

Claims 1-8, 10-14, 16, 18, 41, and 42 have been rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,308,887 to Ko et al. (hereinafter “Ko”). Claims 41 and 42 have been cancelled without prejudice. To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

Ko teaches a radiation-curable pressure-sensitive adhesive (PSA) tape that includes a foam layer comprising “about 80 parts to about 99 parts of an alkyl acrylate monomer, and correspondingly, about 20 parts to about 1 part of a copolymerizable modifier monomer.” (Column 14, lines 33-36). “The foam layer may further include a gas and/or microspheres” as well as fillers. (Column 14, lines 38-47). The foam layer is used in conjunction with a hybrid acrylate/silicone PSA.

Claim 1, as amended, recites an acrylic pressure-sensitive adhesive tape comprising a primer layer disposed between a layer of acrylic backing and a layer of pressure sensitive adhesive. Ko fails to teach or suggest any semblance of a primer layer disposed between the layer of the acrylic backing and the layer of the pressure sensitive adhesive. In fact, the disclosure by Ko that “the foam layer is typically coated with a conventional pressure-sensitive adhesive...” (column 14, lines 17-19) teaches away from the use of a primer layer between the foam layer (acrylic backing) and the PSA.

Because Ko fails to teach or suggest what Applicants claim in their amended claim 1, viz., an acrylic pressure-sensitive adhesive tape comprising a primer layer disposed between the layer of acrylic backing and the pressure-sensitive adhesive, Ko fails to teach or suggest all of the claim limitations of Applicants’ invention. Consequently, because not all of the claim limitations are taught by the Ko reference, a prima facie case of obviousness is not established. Therefore, Applicants’ claim 1 is

necessarily non-obvious. Applicants, therefore, respectfully submit that claim 1 is allowable. The rejection of claim 1 under 35 U.S.C. §103(a) should be withdrawn and claim 1 should be passed to issuance.

Because claims 2-8, 10-14, 16, and 18 depend from claim 1, and because claims that depend from a non-obvious claim are themselves non-obvious, claims 2-8, 10-14, 16, and 18 are necessarily non-obvious. Applicants, therefore, respectfully submit that claims 2-8, 10-14, 16, and 18 are allowable. The rejection under 35 U.S.C. §103(a) should be withdrawn and claims 2-8, 10-14, 16, and 18 should be passed to issuance.

Claims 9 and 15 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Ko in combination with U.S. Patent No. 5,521,227 to Palazzotto et al. (hereinafter "Palazzotto"). The teachings of Ko are presented above. Palazzotto teaches a PSA composition comprising the combination of at least one free-radically photopolymerizable monomer and at least one cationically photopolymerizable monomer and a suitable photoinitiator system. (Column 3, lines 28-31). The composition may be coated onto a backing. (Column 16, lines 60-61). The backing may be release coated with silicone or fluorochemical coatings. (Column 16, lines 65-66).

The subject matter of Applicants' amended claim 1 is presented above. Palazzotto fails to teach a primer layer disposed between the layer of acrylic backing and the pressure-sensitive adhesive, as is recited in Applicants' amended claim 1 from which claims 9 and 15 depend. The primer layer of Applicants' invention is patentably distinct from the release coating of the backing of Palazzotto. In particular, the primer layer of Applicants' invention includes constituents other than the silicone or fluorochemicals of the Palazzotto invention. Furthermore, as a further indication that the primer layer of Applicants' invention and the release coating of Palazzotto are distinct, Applicants point out that while the silicone or fluorochemicals of Palazzotto facilitate the release of the adhesive from the backing, the primer layer of Applicants' invention improves the adhesion of the pressure sensitive adhesive.

The combination of Ko with Palazzotto likewise fails to teach what Applicants claim. In particular, the combination of Ko with Palazzotto yields a PSA tape having a coating that facilitates the release of the tape from a backing. Applicants, on the other hand, claim a PSA tape having a layer disposed between the backing and the adhesive that *improves the adhesion* of the adhesive to the surfaces of the foam-like sheet. Thus, because a primer layer that improves adhesion is not the same as a

release layer that facilitates the release of a tape from a backing, the combination of Ko and Palazzotto does not result in Applicants' invention.

Consequently, because neither Ko nor Palazzotto, alone or in combination, teach or suggest all of the limitations of Applicants' amended claim 1, a prima facie case of obviousness is not established. Therefore, Applicants' claim 1 is necessarily non-obvious. Because claims 9 and 15 depend from claim 1, and because claims that depend from a non-obvious claim are themselves necessarily non-obvious, Applicants respectfully submit that claims 9 and 15 are allowable. The rejection of claims 9 and 15 under 35 U.S.C. §103(a) should be withdrawn and claims 9 and 15 should be passed to issuance.

Claims 17 and 20 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Ko in combination with U.S. Patent No. 5,264,278 to Mazurek et al. (hereinafter "Mazurek"). The teachings of Ko are presented above. Mazurek teaches a hybrid PSA tape product comprising a pressure sensitive layer comprising a silicone, a polymerizable vinyl monomer, a silicate tackifying resin, and a foam layer. The tackifying resin comprises "a sufficient amount of a silicate-MQ ... to impart a degree of adhesive tack to the cured composition...." (Column 4, lines 39-41). Mazurek further teaches the cross-linking of the PSA composition (column 11, lines 20-23) as well as the foam layer as disclosed in Ko (column 13, lines 43-49).

The subject matter of Applicants' amended claim 1 is presented above. Mazurek fails to teach or suggest the use of a primer layer disposed between the layer of acrylic backing and the layer of the pressure sensitive adhesive, as is claimed in Applicants' amended claim 1 from which claims 17 and 20 depend. Furthermore, Mazurek fails to teach or suggest the cross-linking of the acrylic monomer in a foam backing, as is claimed in claim 17.

The combination of Ko with Mazurek fails to teach or suggest the use of a primer layer between the acrylic backing and the PSA, as is claimed in Applicants' amended claim 1. In particular, the combination of Ko with Mazurek teaches a PSA tape having a pressure-sensitive layer comprising a silicone, a polymerizable vinyl monomer, and a silicate tackifying resin disposed at the same foam backing as in Ko. The primer layer, as is claimed by Applicants, is not included in the combination.

Consequently, because neither Ko nor Mazurek, alone or in combination, teach or suggest what Applicants claim in their amended claim 1, viz., an acrylic pressure-sensitive adhesive tape comprising a primer layer disposed between the layer of acrylic backing and the pressure-sensitive adhesive, Ko and Mazurek (alone

or in any combination) fail to teach or suggest all of the claim limitations of Applicants' invention. Because not all of the claim limitations are taught, a prima facie case of obviousness is not established. Therefore, Applicants' amended claim 1 is necessarily non-obvious. Applicants, therefore, respectfully submit that claim 1 is allowable. Because claims 17 and 20 depend from claim 1, and because claims that depend from a non-obvious claim are themselves necessarily non-obvious, Applicants further submit that claims 17 and 20 are allowable. The rejection under 35 U.S.C. §103 should be withdrawn and claims 17 and 20 should be passed to issuance.

Claim 19 has been rejected under 35 U.S.C. §103(a) as being unpatentable over Ko in view of Palazzotto and further in view of Mazurek. The teachings of Ko, Palazzotto, and Mazurek are presented above. The subject matter of Applicants' claim 1 is also presented above. Because Ko, Palazzotto, and Mazurek individually fail to teach or suggest a primer layer disposed between a layer of acrylic backing and a pressure-sensitive adhesive, as is claimed in Applicants' amended claim 1 from which claim 19 depends, any combination of Ko, Palazzotto, and Mazurek also fails to teach or suggest the claimed primer layer. Because the combination of Ko, Palazzotto, and Mazurek fail to teach all of the limitations of Applicants' claim, a prima facie case of obviousness cannot be maintained. Therefore, Applicants' amended claim 1 is necessarily non-obvious and allowable. Because claim 19 depends from claim 1, and because claims that depend from a non-obvious claim are themselves non-obvious, Applicants submit that claim 19 is allowable. The rejection of claim 19 under 35 U.S.C. §103 should be withdrawn and claim 19 should be passed to issuance.

Claims 1-8, 11-14, 18, 41, and 42 have been rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,612,136 to Everaerts (hereinafter "Everaerts"). As stated above, claims 41 and 42 have been cancelled without prejudice.

Everaerts teaches a PSA having improved adhesion to acid-rain resistant automotive paints. The adhesive comprises a cross-linked copolymer comprising at least one monomer selected from the group consisting of monofunctional unsaturated meth(acrylate) esters, a nitrogen-containing basic monomer that is copolymerizable with the ester(s), an optional copolymerizable acidic monomer, and a cross-linking agent. (Column 3, line 49, to column 4, line 57).

The subject matter of Applicants' claim 1 is presented above. Everaerts fails to

teach an acrylic pressure-sensitive adhesive tape comprising a primer layer disposed between the layer of the acrylic backing and the layer of the pressure sensitive adhesive, as is claimed in Applicants' amended claim 1.

Because Everaerts fails to teach or suggest what Applicants claim in their amended claim 1, viz., an acrylic pressure-sensitive adhesive tape comprising a primer layer disposed between the layer of acrylic backing and the pressure-sensitive adhesive, Everaerts fails to teach or suggest all of the claim limitations of Applicants' invention. Consequently, because not all of the claim limitations are taught by the Everaerts reference, a prima facie case of obviousness cannot be established. Thus, Applicants' claim 1 is necessarily non-obvious. Applicants, therefore, respectfully submit that claim 1 is allowable. The rejection of claim 1 under 35 U.S.C. §103(a) should be withdrawn and claim 1 should be passed to issuance.

Because claims 2-8, 11-14, and 18 depend from claim 1, and because claims that depend from a non-obvious claim are themselves non-obvious, 2-8, 11-14, and 18 are necessarily non-obvious. Applicants, therefore, respectfully submit that claims 2-8, 11-14, and 18 are allowable. The rejection under 35 U.S.C. §103(a) should be withdrawn and claims 2-8, 11-14, and 18 should be passed to issuance.

Claims 9, 10, 15, and 16 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Everaerts in combination with Ko. The teachings of Everaerts and Ko are presented above. As stated above, both Everaerts and Ko individually fail to teach an acrylic pressure-sensitive adhesive tape comprising a primer layer disposed between the layer of acrylic backing and the pressure-sensitive adhesive, as is claimed in Applicants' amended claim 1. Furthermore, the combination of Everaerts and Ko would result in a PSA tape in which the PSA comprises a cross-linked copolymer disposed at an acrylic foam layer backing. Such a combination still fails to teach an acrylic pressure-sensitive adhesive tape comprising a *primer layer* disposed between the layer of acrylic backing and the pressure-sensitive adhesive (emphasis added).

Consequently, because neither Everaerts nor Ko, alone or in any combination, teach what Applicants claim in their amended claim 1, a prima facie case of obviousness cannot be established. Therefore, because a prima facie case of obviousness cannot be established, Applicants' claim 1 is necessarily non-obvious. Because claims 9, 10, 15, and 16 depend from claim 1, and because claims that depend from a non-obvious claim are themselves necessarily non-obvious,

Applicants respectfully submit that claims 9, 10, 15, and 16 are non-obvious and therefore allowable. The rejection of claims 9, 10, 15, and 16 under 35 U.S.C. §103 should be withdrawn and claims 9, 10, 15, and 16 should be passed to issuance.

Claims 17 and 20 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Everaerts in combination with Mazurek. The teachings of Everaerts and Mazurek are presented above. Both Everaerts and Mazurek individually fail to teach an acrylic pressure-sensitive adhesive tape comprising a primer layer disposed between the layer of acrylic backing and the pressure-sensitive adhesive, as is claimed by Applicants in their amended claim 1.

The combination of Everaerts and Mazurek fails to teach or suggest the use of a primer layer between the acrylic backing and the PSA, as is claimed in Applicants' amended claim 1. In particular, the combination of Everaerts with Mazurek results in a PSA tape in which the PSA comprises a cross-linked copolymer that is disposed at the same foam backing as in Ko. Such a combination, however, still fails to teach the acrylic pressure-sensitive adhesive tape comprising a primer layer disposed between the layer of acrylic backing and the pressure-sensitive adhesive of Applicants' amended claim 1.

Consequently, because neither Everaerts nor Mazurek, alone or in combination, teach or suggest what Applicants claim in their amended claim 1, viz., an acrylic pressure-sensitive adhesive tape comprising a primer layer disposed between the layer of acrylic backing and the pressure-sensitive adhesive, Applicants' amended claim 1 is necessarily non-obvious. Applicants, therefore, respectfully submit that claim 1 is allowable. Because claims 17 and 20 depend from claim 1, and because claims that depend from a non-obvious claim are themselves necessarily non-obvious, Applicants further submit that claims 17 and 20 are allowable. The rejection under 35 U.S.C. §103 should be withdrawn and claims 17 and 20 should be passed to issuance.

Claim 19 has been rejected under 35 U.S.C. §103(a) as being unpatentable over Everaerts in view of Ko and further in view of Mazurek. The teachings of Everaerts, Ko, and Mazurek are presented above. Any combination of Everaerts, Ko, and Mazurek fails to teach or suggest an acrylic pressure-sensitive adhesive tape comprising a primer layer disposed between the layer of acrylic backing and the pressure-sensitive adhesive, as is claimed in Applicants' amended claim 1. Because the combination of Everaerts, Ko, and Mazurek fail to teach what Applicants claim, Applicants' amended claim 1 is necessarily non-obvious and therefore allowable.

Because claim 19 depends from claim 1, and because claims that depend from a non-obvious claim are themselves non-obvious, Applicants submit that claim 19 is allowable. The rejection of claim 19 under 35 U.S.C. §103 should be withdrawn and claim 19 should be passed to issuance.

Conclusion

Applicants believe that the foregoing amendments and remarks fully comply with the Office Action and that the claims herein are allowable to Applicants. In view of the foregoing points that distinguish Applicants' invention from those of the prior art and render Applicants' invention novel and non-obvious, Applicants respectfully request that the Examiner reconsider the present application, remove the rejections, and allow the application to issue.

If the Examiner believes that a telephone conference with Applicants' attorneys would be advantageous to the disposition of this case, the Examiner is invited to telephone the undersigned.

Enclosed, please find a check in the amount of \$1,680.00 for the filing of a Request for Continued Examination and a three-month extension fee. If additional charges are incurred with respect to this Amendment, they may be charged to Deposit Account No. 13-0235 maintained by Applicants' attorneys.

Respectfully submitted,

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